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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,175	02/11/2002	Hans-Peter Koch	10191/2245	5019

7590 12/29/2005
KENYON & KENYON
One Broadway
New York, NY 10004

EXAMINER

HUSON, MONICA A

ART UNIT PAPER NUMBER

1732

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/074,175	Applicant(s) KOCH ET AL.	
	Examiner Monica A. Huson	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the RCE filed 7 November 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As stated in the paper mailed 19 May 2005, claims 1 (and dependent claims 2-7 and 12-13), and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pressed parts “contain[ing] little or no *more* organic compounds *compared to* pressed parts made of polymer-bonded, soft magnetic composites” (emphasis added; Specification, Page 5, lines 11-14), does not reasonably provide enablement for pressed parts “not including a thermoplastic material” (instant claims 1 and 28), i.e. *containing NO thermoplastic material*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these claims.

Claims 1 (and dependent claims 2-7 and 12-13) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The specification does not contain a description of a method of manufacturing a pressed part wherein a starting mixture does not include a thermoplastic material.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not contain a description of a method of manufacturing a pressed part wherein a starting mixture does not include a thermoplastic material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutz, in view of Bock, as stated in the papers mailed 26 November 2004 and 19 May 2005.

Claim 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Rutz and Bock, as applied to claim 14 above, further in view of Bayer, as stated in the papers mailed 26 November 2004 and 19 May 2005.

Allowable Subject Matter

Claims 8-11 and 24 are allowed, as stated in the paper mailed 19 May 2005.

Response to Arguments

With regard to the rejections based on 35 USC 112 (1st paragraph), applicant contends that claims 1-7, 12, 13, and 28 (now cancelled) do, in fact, fully comply with the 112 (1st paragraph) requirements. However, upon reconsideration, the examiner maintains the rejections. Applicant contends that the previous Office Action did not address whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation. This is not persuasive applicant's disclosed experiment involves Kenolube (Specification, Page 6, lines 1-3, Page 8, lines 6-9), which is a thermoplastic material (See US 6534564, column 12, lines 2-4 for support that Kenolube comprises a thermoplastic material.). Further, the specification discloses a process using materials contain[ing] little or no more organic compounds compared to pressed parts made of polymer-bonded, soft magnetic composites" (Specification, Page 5, lines 11-14). It is again noted that "little or no more organic compounds" does not necessarily indicate a total lack of organic materials, just "little or no more" than comparable items. Additionally, the specification notes that oligoamides can be used an auxiliary pressing agent (Specification, Page 5, lines 27-31); oligoamides are thermoplastic materials (See US 5543489's abstract for support that oligoamides are thermoplastic materials.). It is believed that the undue experimentation necessary would involve experimentation using materials, none of which being thermoplastic.

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Furthermore, applicant contends that his specification does enable a process which does not use a thermoplastic material because there is no mention of the use of a thermoplastic material. Firstly, the examiner believes that there *is* mention of the use of a thermoplastic, as discussed above. However, for sake of argument, the examiner also notes that the mere absence of a positive recitation is not basis for an exclusion (MPEP 2173.05(i)).

With regard to the rejections based on 35 USC 103(a), applicant contains that despite the rejections stated in the Office Action, the claims are patentable for the same reason argued in Applicant's responses filed 28 February 2005. In response to these arguments, the examiner also restates her position as originally noted in the Office Action mailed 19 May 2005 (See pg. 7).


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Monica A Huson
December 15, 2005


MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER